



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,793	01/15/2004	Jordi Albornoz	ROC920030291US1	5432
46797 7590 02/20/2009 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829				
EXAMINER				
PHAM, MICHAEL				
ART UNIT		PAPER NUMBER		
2167				
MAIL DATE		DELIVERY MODE		
02/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/757,793

Applicant(s)

ALBORNOZ ET AL.

Examiner

MICHAEL PHAM

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the remarks filed on 11/25/08, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/John R. Cottingham/

Supervisory Patent Examiner, Art Unit 2167.

Claim Status

2. Claims 9-13 and 25-31 are pending.
3. Claims 9-13 and 25-31 have been examined.

Specification

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 9-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In view of MPEP 2106.IV.B: Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category and based on Supreme Court precedent and recent Federal Circuit decisions, a 35 USC § 101 process must:

1) be tied to another statutory class (such as a particular apparatus) (*Diamond v. Diehr*, 450 U.S.175, 184 (1981); *Parker v. Flook*, 437 U.S. 584 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63,70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876))

OR

2) transform underlying subject matter (such as an article or materials) to a different state or thing (*Gottschalk v. Benson*, 409 U.S. 63,71 (1972); and *In re Bilksi*, Appeal No. 2007-1130).

In view of the above reasons, claim 9 failed to comply to the above 35 USC § 101 requirements 1) or 2), and therefore are directed to non-statutory subject matter. Dependent claims 10-13 are also rejected for failing to resolve the deficiencies of claim 9.

5. Claims 25-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In view of MPEP 2106.IV.B: Determine Whether the Claimed

Invention Falls Within An Enumerated Statutory Category and based on Supreme Court precedent and recent Federal Circuit decisions, a 35 USC § 101 process must:

1) be tied to another statutory class (such as a particular apparatus) (*Diamond v. Diehr*, 450 U.S.175, 184 (1981); *Parker v. Flook*, 437 U.S. 584 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63,70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876))

OR

2) transform underlying subject matter (such as an article or materials) to a different state or thing (*Gottschalk v. Benson*, 409 U.S. 63,71 (1972); and *In re Bilksi*, Appeal No. 2007-1130).

In view of the above reasons, claim 25 failed to comply to the above 35 USC § 101 requirements 1) or 2), and therefore are directed to non-statutory subject matter. Dependent claims 26-31 are also rejected for failing to resolve the deficiencies of claim 25.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 9-13 and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 20040252888 by Barger et. al. (hereafter**

Bargeron) further in view of U.S. Patent Application Publication 20040261016 by Glass et al. (hereafter Glass).

Claim 9:

Bargeron discloses the following claimed limitations “dictating how annotations made for a current versions of a document are applied to a subsequent version of the document, wherein the subsequent version of the document includes one or more revisions to substantive content of the current version of the document; and”[0013 lines 2-6, preserving the intent and meaning of digital ink annotations in an original document whenever the original document takes on a new layout as a result of being edited or displayed ion a different display device or in a different window size. 0014 lines 15-17, the reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified. Accordingly, dictating how (preserving the intent and meaning) annotations (annotation) made for a current versions of a document (0013, original document) are applied to a subsequent version of the document(0014 line 17, digital document is modified), wherein the subsequent version of the document (0014, digital document is modified) includes one or more revisions to substantive content of the current version of the document (0013 line 3, edited; 0014 modified)]

“to dictate how the annotations are applied to subsequent versions of the document”[0017, the annotation must logically be anchored to a region or position in the document where it belongs such that that same region or position in the document can be recovered even if the document’s layout, format, or content changes. The anchoring process defines anchoring rules for each classification of digital ink annotation, and applying these

anchoring rules to each digital ink annotation and generates a logical anchor for each annotation. Accordingly, to dictate how (anchoring process) the annotations (annotations) are applied to subsequent versions of the document (document's layout, format, or content changes)]

Bargerón does not explicitly disclose "selecting one or more annotation versioning policies" and "allowing creators for a current version of a document to select one or more annotation versioning policies".

On the other hand, Glass discloses disclose "selecting one or more annotation versioning policies"[figure 4] and "allowing creators for a current version of a document to select one or more annotation versioning policies"[figure 10]

Both Glass and Bargerón are directed towards annotation systems, and are therefore within applicant's same field of endeavor. Glass is directed to improving classification of a document based on sample documents and annotations, and further allowing for classification of documents by labeling the contents of the document based on human reasoning and document annotation policy. Bargerón is directed to reflowing annotations to an edited document by logically anchoring an annotation to a region or position, and in doing so provides for classification of annotations in order to anchor the annotations. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have applied Glass's disclosure to the disclosure of Bargerón for the purpose easily selecting and controlling annotations through a user interface.

Claim 10:

The combination of Barger and Glass disclose in Barger “wherein at least one of the annotation versioning policies dictates that annotations made for a current version will not be applied to subsequent versions of the document.” [0014, The clean up module is an optional component that can be used to eliminate the user’s original freehand annotations and redraw formalized cleaned-up versions of the annotations. Accordingly, wherein at least one of the annotation versioning policies dictates that annotations (original freehand annotations) made for a current version (original document) will not be applied (redraw) to subsequent versions of the document (cleaned-up version)]

Claim 11:

The combination of Barger and Glass disclose in Barger “the method of claim 9, wherein the one or more annotation versioning policies selected are applied at the document level, to all annotations created for a document.” [0014, The reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified. Accordingly, the method of claim 9, wherein the one or more annotation versioning policies selected (reflow) are applied at the document level (digital document is modified), to all annotations created for a document (original intent and meaning)].

Claim 12:

The combination of Bargeron and Glass disclose in Bargeron “the method of claim 9, wherein at least one of the annotation versioning policies dictates that an annotation created for a current version of a document will be applied to subsequent versions of the document.” [0014, The reflow module insures preservation of the user’s original intent and meaning whenever the digital document is modified.].

Claim 13:

The combination of Bargeron and Glass disclose in Glass “wherein at least one of the annotation versioning policies dictates an authorized user must validate an annotation created for a current version of a document before the annotation is applied to subsequent versions of the document” [See figure 7 element 224, figure 10, and paragraph 0134. Accordingly, wherein at least one of the annotation versioning policies dictates an authorized user (figure 7 element 224) must validate an annotation created for a current version of a document (figure 10) before the annotation is applied to subsequent versions of the document (0134, one version of a document to another).]

Claim 25:

Bargeron discloses “dictating how an annotation created for a current version of a document are applied to one or more subsequent versions of the document, wherein each subsequent version of the document includes one or more versions to substantive content of the current version of the document; and” [Accordingly, dictating how an annotation created for a current version of a document (0013, preserving the intent and meaning of the digital ink

annotation in an original document) are applied to one or more subsequent versions of the document (0014 line 17, digital document is modified), wherein each subsequent version of the document includes one or more versions to substantive content of the current version of the document (0013 line 3 edited; 0014 modified)]

Bargerón does not explicitly disclose “defining a set of annotation policies, each” and providing an interface allowing a user to select one or more of the available annotation policies to be applied to the annotation”

On the other hand, Glass discloses “defining a set of annotation policies, each” (figure 4) and “providing an interface allowing a user to select one or more of the available annotation policies to be applied to the annotation”(figure 10)

Both Glass and Bargerón are directed towards annotation systems, and are therefore within applicant's same field of endeavor. Glass is directed to improving classification of a document based on sample documents and annotations, and further allowing for classification of documents by labeling the contents of the document based on human reasoning and document annotation policy. Bargerón is directed to reflowing annotations to an edited document by logically anchoring an annotation to a region or position, and in doing so provides for classification of annotations in order to anchor the annotations. It would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have applied Glass's

disclosure to the disclosure of Barger on for the purpose easily selecting and controlling annotations through a user interface.

Claim 26:

The combination of Barger on and Glass disclose in Glass “the method of claim 25, wherein defining a set of available annotation policies comprises associating one or more annotation policies for use with annotations made for a certain type of document.” [figure 10, junk]

Claim 27:

The combination of Barger on and Glass disclose in Glass “the method of claim 25, wherein the annotation policies provided to the user in the interface is determined, at least in part, on a credential of the user.” [figure 7 element 224, valid user].

Claim 28:

The combination of Barger on and Glass disclose in “the method of claim 27, wherein the annotation policies provided to the user in the interface is determined, at least in part, on a type of document associated with the annotation.” [figure 10, junk].

Claim 29:

The combination of Barger on and Glass disclose in “the method of claim 25, wherein defining a set of available annotation policies comprises defining the set of available annotation policies by

an administrator, wherein the administrator and the user are different entities.” [0107, administrator].

Claim 30:

The combination of Barger and Glass disclose in Glass “wherein at least one of the annotation versioning policies dictates that an annotation created for a current version of a document and applied to a subsequent version of the document includes a marker indicating that the annotation in the subsequent version of the document is invalidated.” [figure 4, 10, 7. Accordingly, wherein at least one of the annotation versioning policies (figure 4) dictates that an annotation created for a current version of a document (document) and applied to a subsequent version of the document (0134, some of the full text 241 consists of personalizing content that may vary from one version of the document to another) includes a marker (figure 10, check) indicating that the annotation (figure 10, valid text) in the subsequent version of the document (0134, version) is invalidated (figure 10, unchecked, not valid text)]

Claim 31:

The combination of Barger and Glass disclose in Glass “The method of claim 30, wherein the marker is included in the annotation in the subsequent version of the document until an authorized user validates the annotation created for the current version of the document.” [figure 4, 10, 7. Accordingly, wherein the marker (figure 10, check) is included in the annotation (figure 10, valid text) in the subsequent version of the document (0134, version) until an authorized user

validates (figure 7 element 224) the annotation created for the current version of the document (document)]

Response to Arguments

8. Applicant's arguments with respect to claims 9-13 and 25-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's assert the following in regards to Glass reference.

A. Applicant's assert that Glass does not disclose the claimed limitation of a set of annotation versioning policies dictating how annotations made for a current version of a document are applied to a subsequent version of the document.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the current rejection, Bargeron is utilized to disclose dictating how annotations made for a current version of a document are applied to subsequent version of the document and Glass disclosing annotation versioning policies.

Conclusion

9. The prior art made of record listed on pto-892 and not relied, if any, upon is considered pertinent to applicant's disclosure.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PHAM whose telephone number is (571)272-3924. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P./
Examiner, Art Unit 2167

/John R. Cottingham/
Supervisory Patent Examiner, Art Unit
2167